

## **REMARKS/ARGUMENTS**

### ***Status of Claims***

Claims 21-23, 27-35 and 37-57 are pending in the Application.

Claims 1-20, 24-26, and 36 were previously canceled.

Claims 21, 29, 32-35, and 40 are hereby amended.

Claims 41-55 were previously withdrawn.

Claims 56 and 57 are new.

Applicants hereby request further examination and reconsideration of the presently claimed Application.

### ***Response to Election/Restrictions***

The Applicants confirm the election of Group A, claims 21-23, 27-35, 37-40, and 56-57, drawn to a wellbore fluid comprising an ionic water-soluble hydrophobically modified polymer. Upon notice of allowance, Applicants are prepared to authorize an Examiner's amendment to address the previously withdrawn claims 41-55.

### ***35 U.S.C. §112 Rejections***

Claims 21-23, 27-35 and 37-40 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants thank the Examiner for his suggested edits to claims 21 and 40. The Examiner suggested inserting the term "composition" in place of the term "compound" in claim 21. Applicants agree with the Examiner's suggestion and have made the suggested edit to currently amended claim 21 and its dependant claims 32, 33, 34, and 35. The Examiner also suggested inserting the textual reference to claim "27" for the erroneously

referenced claim “39” in claim 40. Again, Applicants concur with the Examiner’s suggestion and have made the suggested edit to the claim language.

Additionally, the Office Action rejected claims 29, 33, and 34 on the ground that “[b]y incorporating two statutory classes into one claim, the metes and bounds of the claim are confusing and therefore the line of infringement becomes ambiguous to the public.” *See* Office Action at 5 (citing MPEP § 2173.05(p)(II)). While Applicants proffer that MPEP § 2173.05(p)(I) provides a claim to a composition of matter “may contain a reference to a process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process,” *see* MPEP § 2173.05(p)(I), Applicants concur with the Office Action’s construction and application of MPEP § 2173.05(p)(II) to claims 29, 33, and 34.

Specifically, the Office Action rejected claim 29 based on a determination that the limitation “released downhole” is “directed to a method of operating or using the composition mixed with the composition limitations.” *See* Office Action at 4-5. In light of MPEP § 2173.05(p)(I), and to remedy the Office Action’s concerns, Applicants have amended claim 29 and added new claim 56.<sup>1</sup> Amended claim 29 now simply reads:

29. The well bore servicing fluid of claim 21, wherein the servicing fluid further comprises a downhole releasable encapsulated salt.

New claim 56 reads:

56. The well bore servicing fluid of claim 29, wherein the encapsulated salt is capable of reducing a temperature of the

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<sup>1</sup> In formulating the claim language of new claims 56 and 57, Applicants graciously acknowledge the Examiner’s acceptance of claim 32’s structure and its use of “capable of” language and hereby incorporate that same structure into the newly presented and amended claims where applicable. Applicants note that new claims 56 and 57 do not include new subject matter, but, rather merely reflect proper claim construction in response to the concerns espoused in the Office Action.

servicing fluid and thereby capable of reducing a viscosity of the servicing fluid.

Likewise, the Office Action rejected claim 33 based on the conclusion that the recitation of the limitation “forms a physically crosslinked gel” is “directed to a method of operating or using the composition mixed with the composition limitations.” *Id.* In light of MPEP § 2173.05(p)(I), and to address the Office Action’s concerns relating to claim 33, the Applicants have amended claim 33 and added new claim 57.<sup>2</sup> Amended claim 33 no longer contains references to “two statutory classes” and now merely reads:

33. The well bore servicing fluid of claim 21, wherein the thermally activated viscosification composition comprises a linear polymer.

New claim 57 reads:

57. The well bore servicing fluid of claim 33, wherein the linear polymer is capable of forming a physically crosslinked gel.

As was the case for claims 29 and 33, the Office Action rejected claim 34 on the ground that claim 34’s recitation of the limitation “forms a thermally reversible gel” is “directed to a method of operating or using the composition mixed with the composition limitations.” *See* Office Action at 5. In light of MPEP § 2173.05(p)(I), and in an effort to present the subject matter of rejected claim 34 in an allowable form, Applicants have amended claim 34 to read:<sup>3</sup>

34. The well bore servicing fluid of claim 21, wherein the thermally activated viscosification composition is capable of forming a thermally reversible gel.

Pursuant to the provisions of MPEP § 2173.05(p), Applicants present amended claims 29, 33, and 34 in allowable forms (along with newly presented claims 56 and 57). Additionally,

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<sup>2</sup> *See supra* note 1.

<sup>3</sup> *See supra* note 1.

Applicants have incorporated the Examiner's suggested edits to claims 21 (with corresponding "composition" for "compound" edits to claim 21-dependant claims 32, 33, 34, and 35) and 40. Based on the foregoing, Applicants respectfully request that the 35 U.S.C. § 112, second paragraph rejections be withdrawn.

### **35 U.S.C. §101 Rejections**

Claims 29, 30, 33, and 34 stand rejected under 35 U.S.C. § 101 because the claims are directed to neither a "process" nor a "composition," but rather embrace or overlap two different statutory classes of invention. The bases for the Office Action's § 101 rejections of claims 29, 33, and 34 have been addressed and rectified via the amendments to claims 29, 33, and 34 as discussed in reference to the Office Action's § 112, second paragraph rejections. *See supra* at 7-10.

Applicants respectfully traverse the Office Action's § 101 rejection of claim 30 as being "directed to neither a 'process' nor a 'composition,' but rather embrace[ing] or overlap[ing] two different statutory classes of invention . . . ." *See* Office Action at 6. Applicants assert that claim 30 is directed specifically to the composition of the "well bore servicing fluid of claim 21." *See* Application, claim 30. Specifically, claim 30 reads:

30. The well bore servicing fluid of claim 29, wherein the encapsulated salt comprises an ammonium salt, a sodium salt, a potassium salt, or combinations thereof.

Based on the foregoing, Applicants respectfully request that the Office Action's § 101 rejections of claims 29, 30, 33, and 34 be withdrawn.

### **35 U.S.C. §102(b) Rejections**

Claims 21-23, 27, 28, 31-35 and 37-39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Le, et al., U.S. 6,169,058 (hereinafter *Le*). According to MPEP § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or

inherently described, in a single prior art reference.” Applicants respectfully submit that the cited prior art does not teach or suggest each and every limitation set forth in the pending claims, and therefore does not anticipate the amended claims.

The Office Action states, “[s]ince *Le* teaches the same composition used in the same manner as claimed, the thermal activity and reversibility of the gel of the *Le* composition would inherently be the same as claimed.” *See* Office Action at 6. Applicants respectfully disagree with the Office Action’s interpretation of *Le* with respect to the instant Application. Applicants contend that *Le* teaches neither the same composition nor the same manner of use as contained in the instant Application. Specifically, referring to amended claim 21, *Le* fails to teach or suggest “[a] well bore servicing fluid comprising a thermally activated *viscosification* composition comprising an ionic *water-soluble, hydrophobically modified polymer*.” *See supra* claim 21 at 2 (emphasis added).

First, regarding the “composition used,” it is incontrovertible, that *Le* teaches that its “polymers are insoluble in water.” *See Le* at col. 3, lines 38-39; col. 4, lines 19-21; col. 5, line 67 – col. 6, line 3; col. 25, lines 13-15 (claim 1); col. 26, lines 16-18 (claim 15); and col. 28, lines 20-22 (claim 34). The instant Application’s polymers are “water soluble.” *See* Application ¶¶ [0014]-[0017]. Additionally, although the Office Action describes *Le*’s “well bore treating fluid” as comprising a “hydrophobically modified polymer,” *see* Office Action at 6, *Le* clearly teaches that its “invention relates to . . . hydrophillic . . . polymers.” *See Le* at col. 1, lines 8-10; *see also* col. 6, lines 50-54; col. 7, lines 42-43; col. 8, line 65 – col. 9, line 26; col.12, line 52; col. 19, lines 3-4, 60-66; and col. 21, lines 49-50. The instant Application’s polymers are “hydrophobic[.]” *See* Application ¶¶ [0014]-[0017].

Second, Applicants respectfully submit that that the instant Application's "thermally activated viscosification composition," *see* amended claim 1, and *Le*'s "superabsorbing particles," *see Le* at col. 8, lines 29-30, are not "used in the same manner." *See* Office Action at 6. Specifically, *Le* teaches "[i]n embodiments of the disclosed method, *fluid loss control* during hydrocarbon-based fracture treatments may be improved by the use of hydrophilic, swelling polymers (sometimes referred to as 'superabsorbing particles') and as a result, the efficiency of hydrocarbon-based fracture treatments are surprisingly improved." *See Le* at col. 6, lines 50-56 (emphasis added). Conversely, the instant Application provides, "[a]s used herein, a 'thermally activated viscosification compound' refers to a compound that causes the viscosity of a fluid in which it is contained to increase as the temperature of the fluid increases and optionally decrease as the temperature of the fluid decreases." *See* Application ¶ [0010]. Clearly, "fluid loss control" and "viscosification" are not the same use. In fact, *Le* specifically distinguishes the use of its "superabsorbing particles" for "fluid loss control" from a "viscosification" use by repeatedly describing its "viscosifying agent additive" as being separate and apart from its "water swellable polymer additive." *See Le* at col. 26, lines 11-14 (claim 15); *see also* col. 25, lines 10-15 (claim 1) ("wherein said first additive viscosities said fluid; and wherein said second additive differs from said first additive and comprises a dispersion of water swellable particles, said particles comprising synthetic hydrophilic polymers that are crosslinked so that said particles are insoluble in water."); and col. 28, lines 11-37 (claim 34) ("wherein said first additive differs from said second additive.").

Lastly, while *Le* specifically identifies its "viscosifying agent additive" as alkylphosphate ester, alkylphosphate ester is not identified as "thermally activated viscosification composition" in the instant Application. *Compare Le* at col. 16, line 59; col. 21, line 29; col. 22, lines 24-25;

col. 29, lines 10-22 (claims 43-44) (“wherein said viscosifying agent additive comprises alkylphosphate ester”); and col. 30, lines 31-34 (claim 58) (“wherein said viscosifying agent additive comprises alkylphosphate ester”) to Application ¶¶ [0014]-[0017].

Based on the foregoing, because *Le* fails to teach or suggest “the same composition used in the same manner as claimed” as the instant Application, *Le* cannot anticipate or render obvious amended claim 21. Consequently, amended claim 21 and its dependent claims (22-23, 27, 28, 31-35, 37-39, and 56-57) should be allowed over *Le*.

### **35 U.S.C. § 103(a) Rejections**

Claims 29 and 30 stand rejected under 35 USC § 103(a) as being unpatentable over *Le* in view of Reddy, et al., U.S. 6,444,316 (hereinafter *Reddy*). Claim 40 stands rejected under 35 USC § 103(a) as being unpatentable over *Le* in view of Tomaszewski, et al., U.S. 5,192,461 (hereinafter *Tomaszewski*). Thus, claims 29, 30, and 40 stand or fall on the application of *Le* to the claims. The requirements for establishing a *prima facie* case of obviousness are well established:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants’ disclosure. MPEP § 2142 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As explained in reference to the § 102(b) rejections above, *Le* fails to teach or suggest the limitations contained in amended claim 21. In addition, all dependent claims incorporate the limitations of the claims they depend on. Because claims 29, 30, and 40 depend on and; therefore, incorporate the limitations of amended claim 21, and *Le* fails to teach the limitations of amended

claim 21, *Le* also fails to teach or suggest the limitations contained in claims 29, 30 and 40. The Office Action does not cite *Reddy*, *Tomaszewski*, or other prior art references, to teach the limitations that are absent from *Le*. Thus, the Office Action does not establish a *prima facie* case of obviousness as to claims 29, 30, and 40, which are allowable over the cited prior art.



## CONCLUSION

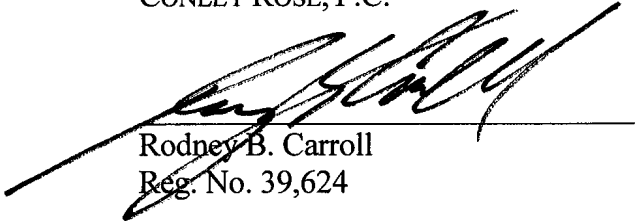
Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Final Office Action dated September 1, 2006 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

CONLEY ROSE, P.C.

Date: 12-1-06

  
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